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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,694	12/30/2003	Nathaniel Blake Scholl	026014-002301US	2002

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EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
12/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,694	SCHOLL, NATHANIEL BLAKE	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08). Paper No(s)/Mail Date *12/10/07,07/02/07,12/22/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims, 6, 11, 18, 19, 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites wherein the information sources include content not generally accessible through the Internet. Since in claim 9 it is indicated that the search result data is derived from

information resources (understood to mean that the search result data is accessed though the Internet by search engine), it is unclear what kind of information is considered "not generally accessible" through the Internet.

Claim 18 recites the method of claim 13 wherein a fee paid for the advertisement associated with the search term is based on prominence of the placement of the link in the search result and number of selections of the link to the item of search results. Claim 18 merely recites ***determining*** whether a user selected a link to the item when the link was included on a page other than the first page, and when it is determined ***requesting*** and advertisement ***to be placed*** on the first page. Claim 13 does not recite if the advertisement is associated with the search term, it is only indicated that advertisement is requested when it is determined the user selected a link on page other than the first page. It is also unclear how the fee is based on prominence of placement of the link and number of selection of the link if the advertisement is requested based on a user selecting a link on page other than the first page. Is the advertisement selected based on a user selecting a link on a page other than the first page or based used on the prominence of placement of the link?

Claims 19 and 30 recite therein a larger fee is paid when the placement is less prominent. It is unclear if the fee is for placement of the link in the search result of placement of the advertisement.

Claims 6, 21, 32 and 21 recites wherein the ***determining*** includes calculating a metric to indicate whether an advertisement for the item should be placed along with search result for a certain search term, the metric being based on number of times users selected a link for the item that was not placed on the first page of the search result. Claims 1 and 13 however recites

"determining whether a user selected a link to an item when the link included on a page other than the first page, so it is unclear how the determining whether a user selected a link on a second page includes "calculating a metric ...".

Claim 13 is recites the limitation "determining whether a user selected a link to *the item* when *the link* was included on a page other than *the first page* of a search result". There is insufficient antecedent basis for this limitation in the claim. Claim 24 is rejected for the same reason.

Claim 14 is recites the limitation "wherein a search engine service provides the link of a search result ". Claim 13 does not recite "a link of a search result". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Calabria et al. (US 2005/0137939 A1).

Regarding claims 1 and 4-12, Calabria teaches receiving search result data for searches that include a link for the item in its search result, the search result data for a search indicating a search term, placement of the link within the search result, and whether user selected the link for

the item; determining based on the received search result data whether users who entered a certain search term subsequently selected the link to the item even though the link was not prominently placed in the search result; and when it is determined that users who entered a certain search term subsequently selected the link to the item even though the link was not prominently placed in the search result, indicating to place an advertisement for the item along with the search result for that certain search term wherein the advertisement is prominently placed along with the search result (see [0006]-[0017], [0021] - [0025], [0053]-[0057] sponsored links ranked based on click-through rate).

Regarding claims 1 and 2, Calabria teaches wherein the link is not prominently placed in the search result when it is not placed on the first page of the search result; wherein the advertisement is prominently placed along with the search result when it is placed on the first page of the search result ((see [0037], [0059], [0072], [0134]).

Regarding claims 13, 21-23, 24 and 32-35, Calabria teaches determining whether a user selected a link to the item when the link was included on a page other than the first page of a search result of a search using a search term; and when it is determined that a user selected a link to the item when the link was included, on a page other than the first page of a search result of a search using a search term, requesting an advertisement to be placed on the first page of a search result for a search using that search term. Calabria teaches advertisement (sponsored) ranked placed based on the amount that are willing to pay also based on click through (see [0021] – [0025], [0037] – [0042]).

Regarding claims 14 and 25, Calabria teaches search engine service provides the link of a search result without payment of an advertisement fee (search result are provided to the user without the user paying advertisement fee).

Examiner would like to point out that whether the search engine service provides the link with or without the payment does not affect the step of "determining whether a user selected a link" and the step of " requesting and advertisement to be placed". Since there is no additional step performed, this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2D 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (fed. Cir. 1994).

Regarding claims 15-20 and 26-32 Calabria teaches wherein a fee is paid for requesting payment of the advertisement; wherein the advertisement is paid for on a cost-per-selection basis. wherein the links are provided without charge to a vendor of the item and the requested advertisement is paid for by the vendor on a cost-per-selection basis; wherein a fee paid for the advertisement associated with the search term is based on prominence of the placement of the link in the search result and number of selections of the link to the item of search results (see [0004] – [0012], [0019] – [0021]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Paine et al. (US 7,225,182 B2) teaches recording each click on a search result.

Meisel et al. (US 7,035,812 B2) teaches multi-element bidding for influencing a position on a search result.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622